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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/682,876   | 10/26/2001  | Mark Duchow          | 670715-90029        | 1765             |
| 26710  | 7590        | 06/01/2004           | EXAMINER            |                  |
| QUARLES & BRADY LLP<br>411 E. WISCONSIN AVENUE<br>SUITE 2040<br>MILWAUKEE, WI 53202-4497 |             |                      | MYHRE, JAMES W      |                  |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             | 3622                 |                     |                  |

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |              |
|------------------------------|-----------------|--------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |
|                              | 09/682,876      | DUCHOW, MARK |
|                              | Examiner        | Art Unit     |
|                              | James W Myhre   | 3622         |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 67-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 67-75 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 5, 2004 has been entered.

### ***Response to Amendment***

2. The amendment filed on April 5, 2004 changed the location of the "Summary of the Invention" section heading to the beginning of paragraph 0008 instead of paragraph 0013. This change has been made to the specification.
3. The amendment filed April 5, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment also altered paragraph 0045 by deleting the words "or resellers" in line 7 and adding the phrase "has the territory that includes, or is" in lines 8 and 9. The original specification does not support selecting the reseller that has the territory that includes or is located closest to the buyer. In original paragraphs 0045, 0067, and 0084 the selection of the

reseller is the reseller who is geographically closest to the buyer. The only place in the original specification that refers to resellers having assigned territories is in the Background of the Invention when discussing franchises. Nowhere in the Summary of the Invention nor in the Description of the Preferred Embodiment is there any mention of the resellers being franchisees, having assigned territories, or using assigned territories as a basis of selecting the reseller.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 68 and 70-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

These claims include or are dependent upon claims which include the limitation that the reseller is selected based on the customer's location being within or closest to a pre-assigned territory of the reseller. As discussed in the Response to Amendment section above (paragraph 3), the original specification does not support selecting the

reseller that has the territory that includes or is located closest to the buyer. In original paragraphs 0045, 0067, and 0084 the selection of the reseller is the reseller who is geographically closest to the buyer. The only place in the original specification that refers to resellers having assigned territories is in the Background of the Invention when discussing franchises. Nowhere in the Summary of the Invention nor in the Description of the Preferred Embodiment is there any mention of the resellers being franchisees, having assigned territories, or using assigned territories as a basis of selecting the reseller.

### ***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Applicant is advised that should claims 68 and 69 be found allowable, claims 71 and 72 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 71 contains all the features and limitations of Claim 68 and its parent claim 67. Likewise, Claim 72 includes all the features of Claim 69 and its parent claim 67. In the second independent claim (Claim 70), the Applicant has taken the first independent claim (Claim 67), removed one feature and added the limitations of Claim 68, and then added the feature back in again with dependent Claim 71. Thus, Claims 68 and 71 includes the same set of features and limitations. The same has been done with reference to Claims 69 and 72.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 67-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al (6,259,405) in view of Scroggie et al (6,185,541).

Claim 67: Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer, comprising:

- a. providing screen displays to allow the customer to enter product selection information, personal ID data, and a postal code (col 20, lines 48-54 and 61-67);
- b. receiving the above data through the Internet (col 9, lines 35);

- c. generating a voucher (offer) redeemable only at one selected reseller (col 27, lines 26-37);
- d. communicating the voucher data to the prospective customer and the selected reseller (col 25, lines 18-32); and
- e. selecting the one reseller based on the product selected and the postal address code (address) of the prospective customer (col 11, lines 21-31 and col 22, lines 22-31).

Stewart discloses the user (MU) entering the product selection information (such as requesting a reservation for a rental car, airline flight, or hotel room), the user's personal ID data and the user's location data (such as an address or geographic location). The system will then select one reseller which can provide the desired product or service based on the user's location and/or demographic information. Once the reseller is selected, Stewart notifies both the user and the reseller. While it is not explicitly disclosed that the user's address includes the postal code, the Examiner notes that in this country the United State Postal Service has required a postal code (i.e. zip code) to be included in the address since the 1960's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the postal code as part of the address in Stewart. One would have been motivated to include the postal code in order to store a complete address for the user. While Stewart discloses selecting the reseller based on the location of the user, it is not explicitly disclosed that the user's postal address code would be used to determine the user's location. However, Stewart discloses a plurality of methods for determining the user's

location, such as wireless local area network access points (i.e. cellular telephone towers), sensors with known locations detecting the presence of the user's mobile unit (e.g. passing through an entrance at an airport), GPS systems, etc. Stewart further discusses the advantages and disadvantages of the various methods due to the sensitivity of the system for determining the user's location, such as LAN access points giving a general location, a GPS system giving the user location within a few feet, or a stationary wired access point giving the exact known location for the wired access point. Furthermore, Scroggie discloses a similar method of distributing a voucher (discount incentive) in which "the user is required to enter his or her ZIP code or other postal code, since many features of the system are location-dependent" (col 6, lines 56-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if only the general location of the user was desired information such as the postal code, telephone area code, or Internet connection point could be used. One would have been motivated to use a general location indicator, such as a postal code, in order to provide a quick method of targeting general area advertisements or promotions, i.e. a promotional program aimed at a large area (city) instead of a specific location (shopping mall).

Claim 68: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 67 above. Stewart further discloses the system selecting a restaurant, rental car agency, or airline serving the user's location based on the stored preferences of the user and the user's location (col

20, line 47 – col 24, line 42). Additionally, Scroggie further discloses that the buyer may go to the manufacturer's offer page and select one or more product offers from a manufacturer (col 7, line 64- col 8, line 21). The system will then select and display one or more local retailers which sell that product. It is inherent that if the product is an exclusive product, i.e. one which is sold by only one retail chain, such as a franchise (e.g. Skilcraft Tools™ sold by Sears), that the system would display the local or closest Sears store. Likewise, if the user selected Kentucky Fried Chicken (KFC) as the manufacturer and fried chicken as the product, the system would select the KFC franchisee which had been assigned coverage of the geographic location of the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Stewart would select the reseller which had been assigned coverage of the geographic location of the user.

Claim 69: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 67 above, and Stewart discloses providing the screen displays through the Internet (col 6, lines 26-29) to allow the prospective customer to enter the desired product, personal ID data, and postal address code prior to the selection of a reseller.

Claim 70: Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer, comprising:

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- a. providing screen displays to allow the customer to enter product selection information, personal ID data, and a postal code (col 20, lines 48-54 and 61-67);
- b. receiving the above data through the Internet (col 9, lines 35);
- c. generating a voucher (offer) redeemable only at one selected reseller (col 27, lines 26-37);
- d. communicating the voucher data to the prospective customer and the selected reseller (col 25, lines 18-32); and
- e. selecting the one reseller based on the product selected and the postal address code (address) of the prospective customer (col 11, lines 21-31 and col 22, lines 22-31).

Stewart discloses the user (MU) entering the product selection information (such as requesting a reservation for a rental car, airline flight, or hotel room), the user's personal ID data and the user's location data (such as an address or geographic location). The system will then select one reseller which can provide the desired product or service based on the user's location and/or demographic information. Once the reseller is selected, Stewart notifies both the user and the reseller. While it is not explicitly disclosed that the user's address includes the postal code, the Examiner notes that in this country the United State Postal Service has required a postal code (i.e. zip code) to be included in the address since the 1960's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the postal code as part of the address in Stewart. One would have been motivated to

include the postal code in order to store a complete address for the user. While Stewart discloses selecting the reseller based on the location of the user, it is not explicitly disclosed that the user's postal address code would be used to determine the user's location. However, Stewart discloses a plurality of methods for determining the user's location, such as wireless local area network access points (i.e. cellular telephone towers), sensors with known locations detecting the presence of the user's mobile unit (e.g. passing through an entrance at an airport), GPS systems, etc. Stewart further discusses the advantages and disadvantages of the various methods due to the sensitivity of the system for determining the user's location, such as LAN access points giving a general location, a GPS system giving the user location within a few feet, or a stationary wired access point giving the exact known location for the wired access point. Furthermore, Scroggie discloses a similar method of distributing a voucher (discount incentive) in which "the user is required to enter his or her ZIP code or other postal code, since many features of the system are location-dependent" (col 6, lines 56-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if only the general location of the user was desired information such as the postal code, telephone area code, or Internet connection point could be used. One would have been motivated to use a general location indicator, such as a postal code, in order to provide a quick method of targeting general area advertisements or promotions, i.e. a promotional program aimed at a large area (city) instead of a specific location (shopping mall).

Stewart further discloses the system selecting a restaurant, rental car agency, or airline serving the user's location based on the stored preferences of the user and the user's location (col 20, line 47 – col 24, line 42). Additionally, Scroggie further discloses that the buyer may go to the manufacturer's offer page and select one or more product offers from a manufacturer (col 7, line 64- col 8, line 21). The system will then select and display one or more local retailers which sell that product. It is inherent that if the product is an exclusive product, i.e. one which is sold by only one retail chain, such as a franchise (e.g. Skilcraft Tools™ sold by Sears), that the system would display the local or closest Sears store. Likewise, if the user selected Kentucky Fried Chicken (KFC) as the manufacturer and fried chicken as the product, the system would select the KFC franchisee which had been assigned coverage of the geographic location of the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Stewart would select the reseller which had been assigned coverage of the geographic location of the user.

Claim 71: This claim includes the same features and limitations as Claim 68 above and is rejected as being obvious as discussed above.

Claim 72: This claim includes the same features and limitations as Claim 69 above and is rejected as being obvious as discussed above.

Claim 73: This claim includes the same features and limitations as Claims 70-72 above and is rejected as being obvious as discussed above.

Claim 74: Stewart and Scroggie disclose a method for distributing a voucher (discount/offer) to a prospective customer as in Claim 73 above, and Stewart further discloses that the selection of the reseller is transparent to the prospective customer (col 20, line 47 – col 24, line 42) in that in several embodiments the customer need only request a rental car, hotel room, or airline ticket; and the system will automatically fill in the customer's ID data and location; and then, based on this data, select and display to the customer the reseller (car rental agency, hotel, or airline) that carries the product or service for the customer's location.

Claim 75: Stewart and Scroggie disclose a method for distributing a voucher (discount/offer) to a prospective customer as in Claim 73 above, and Stewart further inherently discloses that only one voucher is distributed for one product usable at only the selected reseller each time the customer enters a product selection, personal ID data and postal address code. Stewart does not disclose that the customer selects a plurality of products; hence, it implies the customer is selecting only one product. In both the Applicant's invention and in Stewart's invention, if the customer selected a plurality of products it may be impossible for the system to select a single reseller to display to the customer, especially if no single reseller carried all of the selected products. In this case, neither invention discusses how it would determine which

reseller (and directions thereto) would be displayed to the customer first. The examiner further notes that while a marketer could allow multiple coupons to be redeemed for a single item, it is usual and customary in the marketing arts to only allow one voucher (coupon/discount) to be applied to a purchase of a product. Therefore, it would have been obvious to only distribute one voucher for the one product selected by the customer in Stewart. One would have been motivated to only distribute a single voucher in order to prevent a customer from redeeming so many vouchers that the product is free; thus, defeating the purpose of the voucher. For example, if the system issues a \$1.00 discount voucher for a \$5.00 product and the customer redeems 5 of the voucher on a purchase of a single unit of the product, the customer would effectively pay nothing for the product (except possible sales taxes). If the customer redeemed 6 voucher for the same product, the reseller would not only have to give the product to the customer for free, but would also owe the customer an additional dollar.

### ***Response to Arguments***

10. Applicant's arguments with respect to the previous claims have been considered but are moot in view of the new ground(s) of rejection and the newly entered claims.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703)

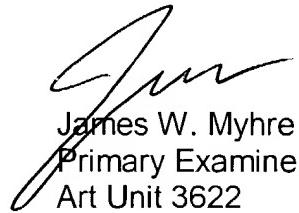
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308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
May 26, 2004

  
James W. Myhre  
Primary Examiner  
Art Unit 3622